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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,160	09/22/2003	Eduard K. de Jong	P8727	1672

24209 7590 01/02/2008  
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EXAMINER
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HOMAYOUNMEHR, FARID

ART UNIT	PAPER NUMBER
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2132

MAIL DATE	DELIVERY MODE
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01/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/669,160

Applicant(s)

DE JONG, EDUARD K.

Examiner

Farid Homayounmehr

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: application, filed 9/22/2003; amendment filed 10/1/2007.
2. Claims 1-86 are pending in the case.

### ***Response to Arguments***

3. Double Patenting Rejection:

With regards to Double Patenting rejection, applicant argues that claim 3 of the '719 application (application number 10/243'355) has been cancelled, and therefore the limitations of the '719 application does not make the claimed invention obvious. The argument is found persuasive, however, a double patenting rejection based on other claims of the '719 application is outlined in the next section. Therefore, the obviousness-type provisional Double Patenting is maintained. Examiner also notes that applicant argues that to arrive at claim 1 in the instant application requires elimination of the token and its recited properties from '719 application. However, Double Patenting requires that all limitations of the instant application be anticipated or made obvious by the other commonly owned patent. It is not necessary for the instant application to make the other application obvious. In other words, if a subset of the claims of the commonly owned

patent makes the instant application obvious, the Obviousness-type Double Patenting is valid.

4. Prior Art Rejections:

With regards to rejection of claims 1, 10, 19 and 28 under section 102(e) applicant argues that Muntz does not teach the requirement of one or more delivery parameters identifying the target device. However, as identified by the Specification, and admitted by the applicant, "delivery parameter" describes any value used to determine the destination or target device to which the content is delivered. Page 4 of the Final rejection, mailed 6/27/2007, clearly shows how Muntz identifies a destination or target device. Applicant argues that the "delivery parameters" are reduced to a gist. However, as mentioned above, "delivery parameters" are any value that identifies a target system. Page 4 of Final rejection shows how Muntz identifies the target. It is not clear how this rationale has reduced the definition to a gist.

With regards to claims 2-9, 11-18, 20-27 and 29-86, applicant argues that the rejection failed to demonstrate how knowledge of a tokenized URL teaches a token pool.

However, Examiner has taken the Official Notice that general methods of token generation, such as token pools were well known in the art at the time of invention. The claimed invention does not identify specific details of token generation using token pools that is distinguishable from general method of token generation. Applicant further

argues the limitations of “determining a token pool associated with said digital content; determining a token in said token pool; and creating a tokenized URL based at least in part on said token” is not considered in the rejection. However, as mentioned in rejection of claim1, Muntz teaches tokens associated with digital content (see parag. 23). Examiner takes the Official Notice that use of URLs and Tokenized URLs to identify the location of data in a resource were well known at the time of invention. Therefore, it would have been obvious to create a tokenized URL in order to use it to identify the location of data (token). Note once again that identifying the location of data is the primary purpose of URLs and Tokenized URLs, as exemplified by their extended in the World Wide Web.

With regards to claim 6, applicant argues that the rejection does not show a serial number that identifies the target. However, the rejection clearly shows that the target device is identified. Identifying a device using a serial number was well known in the art at the time of invention. For example, devices connected to a local area network LAN extensively used MAC addresses to identify the connected devices. The communication protocol delivered packets to the target devices based on the MAC address, which is a serial number assigned by the manufacturer of the NIC. Therefore, use of serial numbers to identify the target device in a network would have been obvious to the one skilled in art.

With respect to claims 7 and 9, applicant mentions that the claims further define the delivery parameters, but does not specify how the associated rejection fails to make the requirements obvious.

With respect to Claim 33, 50, 67 and 84, applicant argues that there has been no teaching cited of delivery parameters as recited in these claims, a target ID, or the specific limitations recited in the claims. However, in addition to the associated rejections, pages 7-9 of the Final rejection explains how the rejection addresses all required limitations of the mentioned claims.

Applicant further argues that the specific limitations on how the target key and the first key are obtained is not disclosed. However, the specific limitations mentioned by the applicant are determining the target key based on a target ID identifying the target device, or applying a cryptographic process to a first key and the content request to get the session key. Therefore, the cited limitations refer to creating a session key based on a combination of other keys (parameters) using a cryptographic process. Examiner has taken the official notice that this process is well-known to the one skilled in art. In other words combination of several parameters associated with the elements of an authentication process, such as the identification of the target system or the received request, was broadly used and practiced before the time of invention. As an example, see section page 175 of the text book "Applied Cryptography" by B. Schneier, a copy of which was included with the Final Office Action. Therefore, barring any expressed

unexpected results from the particular selection of parameters or the process of combination, it would have been obvious to the one skilled in art to provide the session key as identified by limitations of claim 33.

With regards to claims 34-49, 51-66, 68 -83, 85 and 86, applicant argues that there is no reference shown for token pool, or tokens in the pool having different characteristics, or tokens associated with digital content. These concepts are reflected in the documents identified in Notice of References Cited, such as US 5'943'424, which teaches token pools and use of tokens in authenticated transactions, or US 6'961'858, which teaches the use of tokens for identifying the encryption protocol or cryptographic process to be used.

Based on the discussion above, Examiner has provided a *prima facie* case of obviousness based on the cited references and what is known in the prior art. The next section outlines the currently applicable rejections.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See, *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1/130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-4, 10-13, 19-22, 28, and 30-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, and 6 of Application No. 10/243'355 (de Jong et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because de Jong discloses:

de Jong claim 6: A method for digital content access control, the method comprising: sending, from a user device, a digital content request comprising a request for digital content to a content provisioner capable of authenticating said request; creating, by said content provisioner, an authenticated digital content request based at least in part on



said digital content request if access to said digital content is authorized;  
communicating, by said content provisioner, said authenticated digital content request to a content repository capable of returning said digital content directly to a user in response to said authenticated digital content request from said authenticated digital content request wherein said content repository is different from said user device; and receiving, by said user device directly from said content repository, digital content corresponding to said digital content request.

de Jong claim 1: A method for digital content access control, the method comprising: sending a digital content request comprising a request for digital content to a content provisioner capable of authenticating said request; receiving an authenticated digital content request in response to said digital content request; and sending said authenticated digital content request to a content repository that provides storage for said digital content.

de Jong claim 2: The method of claim 1, further comprising receiving said digital content in response to said authenticated digital content request:

de Jong claim 5: The method of claim 1 wherein said token is from a token pool associated with the location of digital content for which access is authorized.

Claims 1, 10, 19, and 28 of the instant application are obvious over claims 6 and 1 above, as they produce a method for digital content access control, comprising: receiving by a content provisioner a digital content request from a user device, comprising a request for digital content (claim 6 first paragraph shows sending the request from a user to a content provisioner); creating, by said content provisioner, an authenticated digital content request if a user associated with said digital content request is authorized to access said digital content (claim 6, paragraph 2); determining, by said content provisioner, one or more delivery parameters, said one or more delivery parameters identifying a target device to receive said digital content, wherein one or more parameters is used to determine the target device (claim 6 shows that the content provisioner communicates the request to a content repository, and the content repository sends the content directly to the user. Therefore, the identity of the target receiving the content must be identified to the content repository. Therefore, it would have been obvious to include the target identity by the content provisioning device and sending it to the repository. Note that the user has already sent an authenticated request to the content provisioner (claim 6, paragraph 1), and therefore the content repository knows the identity of the user who will be receiving the content); and sending, by said content provisioner, said authenticated digital content request including said one or more delivery parameters (claim 1, last paragraph).

Claims 2, 3, 11, 12, 20-21, 30-31 of the instant application are obvious over claims 1, 6 and 5 above, as they produce limitations of claim 1 and wherein said digital content

request comprises a Universal Resource Locator (URL); said authenticated digital content request comprises a tokenized URL; and said creating further comprises: determining a token pool associated with said digital content; determining a token in said token pool; and creating a tokenized URL based at least in part on said token.

Claims 4, 13, 22 and 32 of the instant application are obvious over claims 1, 3 and 5 above, as they produce limitations of claim 1 and wherein said token is from a token pool associated with the location of digital content for which access is authorized.

7. This obviousness-type double patenting is a provisional rejection as the conflicting claims have not been patented.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 10, 19 and 28 rejected under 35 U.S.C. 102(e) as being anticipated by Muntz et al. (US Patent Application Publication No. 2003/0208681, filed May 6, 2002).

9.1. As per claims 1, 10, 19 and 28 Muntz is directed to a method for digital content access control, comprising: receiving, by a content provisioner, a digital content request comprising a request for digital content (Fig. 5A and associated text, and in particular paragraph 39); creating, by the content provisioner, an authenticated digital content request (Fig. 3 and associated text describes creation of a block list and a token identifying the resource to be accessed, the operations that could be performed on the resource and the user credentials) if a user associated with said digital content request is authorized to access said digital content (for example, paragraph 31); determining, by said content provisioner (Muntz client 105 is the target device (which receives the data and credentials) and the Administrative Server 104 (part of which is the Metadata Server 214) is the Content Provisioner. Per paragraph 19, metadata server sends the block list and the validation mechanism to the client 105. As indicated in Fig. 1 and paragraphs 12-14, client 105 and the metadata server are connected via network. To communicate via network, the metadata server is required to identify the client as recipient of data, otherwise a network connection to transmit data cannot be established. In addition, per paragraph 32, the client 105 and Metadata server authenticate each other. This explicitly shows that the Metadata server identifies the client 105.), one or more delivery parameters, said one or more delivery parameters identifying a target device to receive said digital content (the block list and the token determine access parameters and credentials of the user and the client device); wherein said one or more delivery parameters is used to determine said target device

(as mentioned above, the content provisioner determines delivery parameters which identify the target. Therefore, the delivery parameters are used to identify the target. In addition, per paragraph 32, the token includes credentials, such as operation type(s) authorized for the client. The token is generated by the metadata server. If the token identifies the operations allowed by the client, it must also identify the client, and is used to identify the client. Note that per parag. 13, client 105 may include computer or computer systems.); and sending, by said content provisioner, said authenticated digital content request including said one or more delivery parameters (paragraph 19).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-9, 11-18, 20-27 and 29-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muntz et al. (US Patent Application Publication No. 2003/0208681, filed May 6, 2002) in view of Official Notice.

11.1. As per claim 2, Muntz is directed to the method of claim 1 wherein said digital content request comprises a Universal Resource Locator (URL); said authenticated digital content request comprises a tokenized URL; and said creating further comprises:

determining a token pool associated with said digital content; determining a token in said token pool; and creating a tokenized URL based at least in part on said token (Muntz teaches identification of the resource to be accessed using a token and a block list as identified in rejection of claim 1. Examiner takes the official notice that a common and widely practice mechanism to identify a resource and credentials needed to access the resource is using URLs and tokenized URLs. It would have been obvious to a person skilled in art to use a tokenized URL as a mechanism to implement Muntz block list and token).

11.2. As per claim 3, Muntz is directed to the method of claim 2 wherein said tokenized URL further comprises a cryptogram based at least in part on an identifier that describes the location of said digital content (Muntz teaches creating a encryption of the token and the block list in paragraph 39. Note that the token and/or the block list include information that identifies the resource, and therefore once encrypted, creates a cryptogram based on characteristics of the resource).

11.3. As per claim 4, Muntz is directed to the method of claim 2 wherein said token is from a token pool associated with the location of digital content for which access is authorized (generation or selection of tokens from a token pool to identify and describe the resource to be accessed was well-known at the time of invention).

11.4. As per claim 5, Muntz is directed to the method of claim 1, further comprising synchronizing with said content repository if synchronization is enabled (paragraph 23 teaches synchronization with the resource storage during authorization process).

11.5. As per claim 6, Muntz is directed to the method of claim 1 wherein said one or more delivery parameters comprises a serial number uniquely identifying said target device (paragraph 23 shows the credentials of the user and the client device are part of the authorization combination).

11.6. As per claim 7, 8 and 9 Muntz is directed to the method of claim 1, which describes a method for access control to digital data and determining whether the client is authorized to access data. After the access authorization is determined, the next step is secure delivery of digital content. Examiner takes the official notice that use of a token to specify and communicate the parameters associated with the content delivery encryption protocol, such as the cryptographic process and methods to derive keys for encryption and decryption was well-known at the time of invention.

11.7. Limitations of claims 10-32 are substantially the same as limitations of claims 1-9 above.

11.8. As per claim 33, Muntz is directed to a method for digital content access control, comprising: receiving, by a content repository, an authenticated digital content request

including one or more delivery parameters (Fig. 3 item 216 and Fig. 5B and associated text shows reception of an authenticated digital content request by a block server), wherein said one or more delivery parameters is used to determine the target device (see claim 1) said authenticated digital content request based at least in part on a digital content request comprising a request for digital content (see response to claim 1); validating, by said content repository, said authenticated digital content request, said validating comprising indicating said authenticated digital content request is valid if said authenticated digital content request is validly associated with said digital content and if said authenticated digital content request authenticates said digital content request (paragraphs 27-29); determining, by said content repository, a session key if said authenticated digital content request is valid (paragraph 28), said determining comprising: determining a target key based at least in part on a target ID obtained using said one or more delivery parameters, said target ID identifying a target device; and applying a cryptographic process to a first key based at least in part on at least part of said authenticated digital content request together with said target key to create said session key; encrypting said digital content using said session key; and sending said encrypted digital content (as mentioned in response to claim 1, creation of a session key to encrypt the digital content for secure delivery to a target device was well-known and commonly used at the time of invention).

11.9. As per claim 34, creation of the session key based on another master key and parameters identified in a token were well-known at the time of invention.



11.10. Limitations of claims 35-41 are substantially the same as limitations of claims 1-9 and 33-35 above.

11.11. As per claim 42-45 Muntz is directed to the method of claim 33 wherein said validating further comprises: receiving a token; indicating said token is invalid if said token is not associated with an partially redeemed or unredeemed offset within a token offset window, said token offset window comprising one or more offset entries identified by a base number and an offset from said base number, said one or more offset entries associated with a token in a token pool formed by applying a cryptographic process to the sum of said base number and said offset from said base number, together with a token chain key, said token pool associated with said digital content; and updating the offset entry associated with said token and indicating said received token is valid if said token is associated with a partially redeemed offset or unredeemed offset within said token offset window (Muntz is directed to limitations of claim 33 as discussed above. The additional limitations are directed to a method of checking the validity of a token selected from a token pool, wherein the token pool is associated with a digital content for controlling user access. Examiner takes the official notice that this method was well known in the art at the time of invention, and it would have been obvious to the person skilled in art to use the method to control and limit user access to digital data).

11.12. Limitations of claims 46-86 are substantially the same as limitations of claims 1-45 above.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farid Homayounmehr whose telephone number is 571 272 3739. The examiner can normally be reached on 9 hrs Mon-Fri, off Monday biweekly.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Farid Homayounmehr

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12,26,07